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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.      | CONFIRMATION NO. |
|---|-------------|----------------------|--------------------------|------------------|
| 10/630,440  | 07/29/2003  | Yem Chin             | BSEN119700               | 7928             |
| 26389   | 7590        | 06/20/2005           | EXAMINER                 |                  |
| CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC<br>1420 FIFTH AVENUE<br>SUITE 2800<br>SEATTLE, WA 98101-2347 |             |                      | FLANAGAN, BEVERLY MEINDL |                  |
|   |             | ART UNIT             | PAPER NUMBER             |                  |
|   |             | 3739                 |                          |                  |

DATE MAILED: 06/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                 |                  |
|------------------------------|---------------------------------|------------------|
| <b>Office Action Summary</b> | Application No.                 | Applicant(s)     |
|                              | 10/630,440                      | CHIN ET AL.      |
|                              | Examiner<br>Beverly M. Flanagan | Art Unit<br>3739 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.



BEVERLY M. FLANAGAN  
PRIMARY EXAMINER

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/24/05
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Information Disclosure Statement***

The information disclosure statement filed March 24, 2005 has been made of record and the references cited therein have been considered by the examiner.

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 15 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 14 of copending Application No. 10/793,482. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Seibel (U.S. Patent Application Publication No. 2001/0055462).

**In regard to claims 1, 2, 4 and 15-20,** Seibel teaches a scanning optical fiber 80 comprised of a plurality of photon detectors 92 arrayed around a central optical fiber 94 (see Figure 3A). Optical fiber 94 is caused to vibrate in the direction indicated by arrow 98 by a tube piezoelectric actuator 95 through which the optical fiber extends (see Figure 3A and section 0077). Figures 3A and 3B show that the piezoelectric actuator 95 causes the distal end of optical fiber 94 to move relative to the imaged area to increase the field of view. **In regard to claim 3,** Seibel teaches an embodiment comprised of an optical fiber 244 that has a ball lens 245 at its distal end (see Figure 5H) as well as other embodiments with distal lenses (see lens 154 in Figure 4B). **With further respect to claims 4 and 15-19,** Seibel teaches that alternate actuators from the piezoelectric actuator 95 can be used, such as electromechanical systems having a first and second actuators (see section 0079). **In regard to claim 5,** Seibel teaches the use of illumination fibers, such as optical fiber 284 and optical fiber 300 (see Figure 6C and section 0105). **In regard to claim 6,** Seibel teaches a light source system 340 comprised of red, green and blue light sources 342, 344 and 346, respectively, and a UV light source 348 (see section 0106). Seibel also teaches retrofitting an existing endoscope 540 with the optical fiber assembly 542 where light emitted by the scanning optical fiber is reflected from a beam splitter 554 (see section 0160). **In regard to claims 7-9,** Seibel teaches that the endoscope 540 is provided with a CCD 566 and the

signal produced by the CCD is conveyed through a lead 568 externally to enable imaging of tissue (see section 0160). Seibel also teaches an alternate embodiment having a computer workstation 462 with a high resolution color monitor 464 for displaying the image (see section 0148). **In regard to claims 10-14**, see sections 0110, 0150 and 0152.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant should note the following prior art references disclosing vision catheters with means to vibrate the distal end to increase the field of view: Kimura, U.S. Patent No. 4,846,155; Hibino et al., U.S. Patent No. 5,060,632 and Japanese Publication No. JP 1-237613.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beverly M. Flanagan whose telephone number is (571) 272-4766. The examiner can normally be reached on Mondays, Tuesdays and Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Beverly M. Flanagan  
Primary Examiner  
Art Unit 3739

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